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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,205	12/12/2000	Kaoru Okuno	50212-174	1983
20277	7590	02/09/2004	EXAMINER	
MCDERMOTT WILL & EMERY 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/734,205

Applicant(s)

OKUNO ET AL.

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-15-04 has been entered.

### ***Election/Restrictions***

Claims 3-5 are rejoined because they appear to be now directed to a scope which is not mutually exclusive of the originally elected species. The apparatus claims are not rejoined for substantially the same reasons they were previously withdrawn.

### ***Specification***

The spacing of the words of the specification is such as to make reading and entry of amendments difficult. For example, see lines 17-18 of page 1: there is essentially no spacing between the words.

A substitute specification is required pursuant to 37 CFR 1.125(a) because of the lack of spacing.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37

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CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c)

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 3-5 are directed to changing an amount of heat in response to the changing of a gas flow rate. Examiner could find no basis for such a step in the specification. This is a prima facie showing of failure to comply with the written description requirement. The burden is now on Applicant to demonstrate that the written description requirement.

Claim 1: there doesn't seem to be any support for a "predetermined changing". Furthermore, the claim seems to require that the tension has the changing along the direction of the fiber. It is not understood how a tension can "have" a changing: thus there doesn't seem to be any support for this. (see below also)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 10 refers to a "changing". Examiner could find no mention of this changing in the specification. It is unclear what a "changing" is - and equally important, what has the changing. A 'changing of the guard' comes to the mind of Examiner, which would be that a palace has the changing of the guard. The guard doesn't have the changing of the guard. If any parallel is appropriate, then the claims seems to suggest that the tension has a changing of something. Regardless, Examiner is uncertain as to what is actually claimed by the present language and what was intended.

Claim 4: there is no antecedent basis for "the heat dissipated" and "the dissipating condition".

***Claim Rejections - 35 USC § 103***

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roba 6371394.

The paragraph spanning cols. 6-7 discloses the use of the furnace of 5114338 or 4969941 - each of which have a furnace core tube. It would have been obvious to insert the Roba preform (see Roba fig 1) into the tube, than to build the tube around the preform, because it would be easier to insert the preform.

The step of heating and the step of drawing are clearly shown in figure 1 and are elsewhere described in Roba.

The tension measuring step is disclosed at col. 8, lines 29-35.

A heat changing step is present: see col. 7, lines 4-7 and 37-40. The change of heat is not dependant solely on the main heater: col 7, lines 37-40.

As to the heat changing being "in response to the measured glass draw tension". Roba doesn't explicitly mention this. However, col. 9, lines 28-34 discloses controlling the process "on the basis of the values of pre-set **process parameter** values and on the basis of the signals" from the sensors "along the tower". Tension is a signal from a sensor along the tower, see col. 8, lines 29-35. There is no indication of any process parameter values which are "pre-set"; however col. 7, line 5 identifies the furnace temperature (and thus heat) is a **process parameter** which is controlled. It is deemed that the passage at col. 9, lines 28-34 sets forth that any of the disclosed **process parameters** could use pre-set values: since Roba only mentions a few **process parameters** it is deemed that any discussion of **process parameters** encompasses at least each of the specific **process parameters** mentioned by Roba.

Interpretation of the phrase "so as to" is as follows: The conjunction "so" has two senses. One sense signifies a result, the other a purpose: 'with the result that' vs. 'in

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order that'. Each is a reasonable interpretation. The Office interprets claims with their broadest reasonable interpretation. The "in order that"/purpose sense/definition is the broadest of the two definitions. Therefore, the claim is interpreted as not requiring the result of having a predetermined changing. Likewise the limitation "to change" merely indicates a purpose, not a result.

Nevertheless the local chromatic dispersion is inherently changed. It would have been inherently predetermined, based on the operational parameters chosen.

In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The limitation "to change the measured glass draw tension..." is simply an intention with no manipulative difference; the claim does not require that the tension actually reach a predetermined value.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

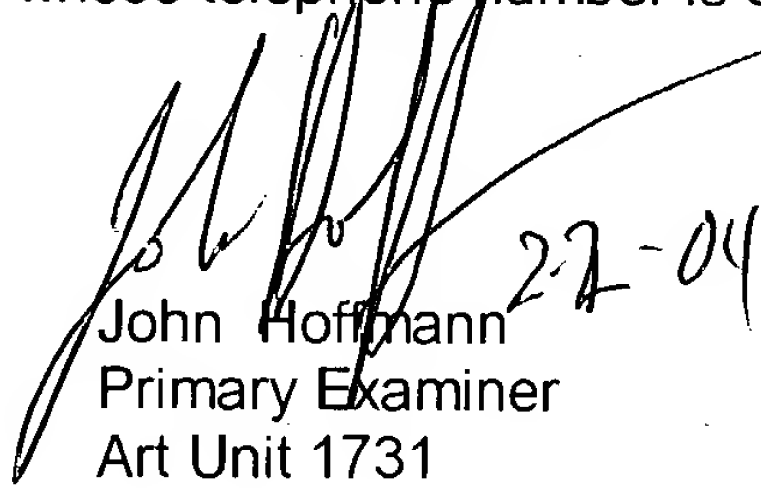
Although a copy of the specification is filed, it was not submitted as an amendment so as to actually change the specification. Note the improved statement as to what is required. Examiner apologizes for not carefully reviewing the form paragraphs used and removing all vagueness therefrom.

It is argued that claim 1 comprises a manipulative step of changing the chromatic dispersion. Examiner disagrees. The only manipulative steps in claim 1 are the steps of: heating, drawing, measuring, and changing. As indicated in the rejection above, the "so as to have" language is merely purpose, not a result nor a manipulative step. Furthermore, the process would inherently result in a change in chromatic dispersion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272-1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.

 2-2-04  
John Hoffmann  
Primary Examiner  
Art Unit 1731

jmh